

Bills Committee on Trade Marks Bill

Parallel Importation of Trade Mark Goods - the Position in Australia and Singapore

Introduction

This note sets out briefly our understanding of the respective positions in Australia and Singapore regarding the treatment of parallel imported trade mark goods

The Position in Australia

2. Section 123 of the Australian Trade Marks Act 1995 provides as follows -

(1) "In spite of section 120, a person who uses a registered trade mark in relation to goods that are similar to goods in respect of which the trade mark is registered does not infringe the trade mark if the trade mark has been applied to, or in relation to, the goods by, or with the consent of, the registered owner of the trade mark."

(2) "In spite of section 120, a person who uses a registered trade mark in relation to services that are similar to services in respect of which the trade mark is registered does not infringe the trade mark if the trade mark has been applied in relation to the services by, or with the consent of, the registered owner of the trade mark."

3. In one recent case *Transport Tyre Sales Pty Ltd v Montana Tyres Rims & Tubes Pty Ltd* [1999] FCA 329 (29 March 1999), the Full Court of the Federal Court of Australia held that "the term 'trade mark' imports no territorial limitation at all". It is "a physical manifestation, or sign, which may be registered." "A sign may be applied to goods or in

relation to goods or services in any part of the world. It is nevertheless capable of being a trade mark within the meaning of the Act, notwithstanding that it is applied to the goods or in relation to goods or services outside of Australia. It is also capable of being a trade mark within the meaning of the Act, whatever may have been the intention, if any, of the person who applied the mark. When Section 123 refers to a trade mark which 'has been applied to, or in relation to' goods, or 'has been applied in relation to' services, it is immaterial where the application occurs. It is equally immaterial to enquire as to the intention of the registered owner of the trade mark by whom or with whose consent the trade mark has been so applied." (paragraphs 77 to 80 of the judgment).

The Position in Singapore

4. Section 29 of the Singaporean Trade Marks Act 1998 provides that -

(1) "Notwithstanding section 27, a registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market, whether in Singapore or outside Singapore, under that trade mark by the proprietor of the registered trade mark or with his express or implied consent (conditional or otherwise)."

(2) "Subsection (1) does not apply where the condition of the goods has been changed or impaired after they have been put on the market, and the use of the registered trade mark in relation to those goods is detrimental to the distinctive character or repute of the registered trade mark."

5. The Singaporean Trade Marks Act came into force on 15 January 1999. We are not aware of any decided case in Singapore in respect of parallel imports under this new trade marks law.

Trade and Industry Bureau
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